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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,857	08/17/2006	Johann Bonn	294566US0PCT	3534
22850 7590 04/01/2010 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER JOHNSON, KEVIN M				
ART UNIT 1793		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 3/16/2010 have been fully considered but they are not persuasive.

The argument that applicants arguments directed to the consideration of a solution to a long existing problem in the sizing industry is not persuasive. The remarks in the arguments submitted 7/29/2009 failed to adequately establish the argument that applicant's had solved a long-standing problem in the art. Applicant has provided no factual evidence to show that the prior art recognized sizing performance as a long-standing problem. All discussion associated with this section of applicant's argument was directed to the improved performance of the instant sizing dispersion, which is not sufficient to show a long-standing need. In *In re Spinnable*, which applicant appears to rely on to support this argument, the problem solved by the applicants was recognized by the prior art but was expressly not remedied therein. In this case there has been no evidence provided to show that the prior art recognized the issue and believed it to not be remedied. The failure to provide evidence of a long felt need effectively converts applicant's arguments submitted 7/29/2009 to arguments of unexpected results, an interpretation consistent with the language utilized and factual references of applicant's arguments.

The argument that the office's assertion that the evidence provided by applicant fails to rebut the *prima facie* case of obviousness because the unexpected results would naturally from the suggestion of the prior art is incorrect and is not persuasive. When

considering the evidence rebutting the *prima facie* case of obviousness based on secondary considerations, such as unexpected results, the strength of the evidence must be compared to the strength of the *prima facie* case of obviousness. In the instant case the evidence pointed to by applicant to support a claim of unexpected results shows only that two prior art sizing dispersions exhibit inferior properties compared to dispersions exemplary of the instant invention. This comparison fails to adequately support the conclusion drawn by applicant's that the selection of a protective colloid substantially free of diketenes results in improved sizing performance. This failure is due to the fact that applicant's own evidence establishes that factors other than diketene content of the protective colloid affect the performance of the size. For example, Dispersion 4 in the instant specification exhibits improved performance when compared with Dispersion 3, and because both dispersions meet the requirements of the instant claims with respect to the diketene content of the protective colloid the conclusion must be drawn that other factors also influence the performance of the size. Additionally, Dispersion 4 exhibits a greater Cobb 60 performance enhancement when compared with Dispersion 3 than Dispersion 3 does with respect to the comparative dispersions disclosed in the instant specification indicating that the other factors affecting the performance of the size have a greater impact than the diketene content of the protective colloid. When these conclusions are considered, the evidence submitted by the applicant is not considered to be sufficient to overcome the *prima facie* case of obviousness based on the expectation that the unexpected results would naturally flow from the suggestion of the prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEVIN M. JOHNSON whose telephone number is (571)270-3584. The examiner can normally be reached on Monday-Friday 9:00 AM to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Mayes can be reached on 571-272-1234. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kevin M Johnson/  
Examiner, Art Unit 1793

/David M Brunsman/  
Primary Examiner, Art Unit 1793